



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|------------------------|-------------------------------|------------------------|
| 10/799,939 | 03/11/2004 | Charles B. Worrick III | 00216-664001 / Case 8134 | 8003 |
| 26161 7590 06/21/2007 FISH & RICHARDSON PC P.O. BOX 1022 MINNEAPOLIS, MN 55440-1022 | | | EXAMINER MICHALSKI, SEAN M | |
| | | | ART UNIT 3724 | PAPER NUMBER |
| | | | MAIL DATE 06/21/2007 | DELIVERY MODE PAPER |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/799,939

Applicant(s)

WORRICK ET AL.

Examiner

Sean M. Michalski

Art Unit

3724

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 May 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,7-10,12,13,15,18-21 and 24-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3,7-10,12,13,15,18-21 and 24-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 5/21/2007 has been entered.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 3, 7-10, 13, 15, 18-21, 25 and 26 rejected under 35 U.S.C. 103(a) as being unpatentable over Apprille'071 in view of Kirk (USPN 3,048,673).

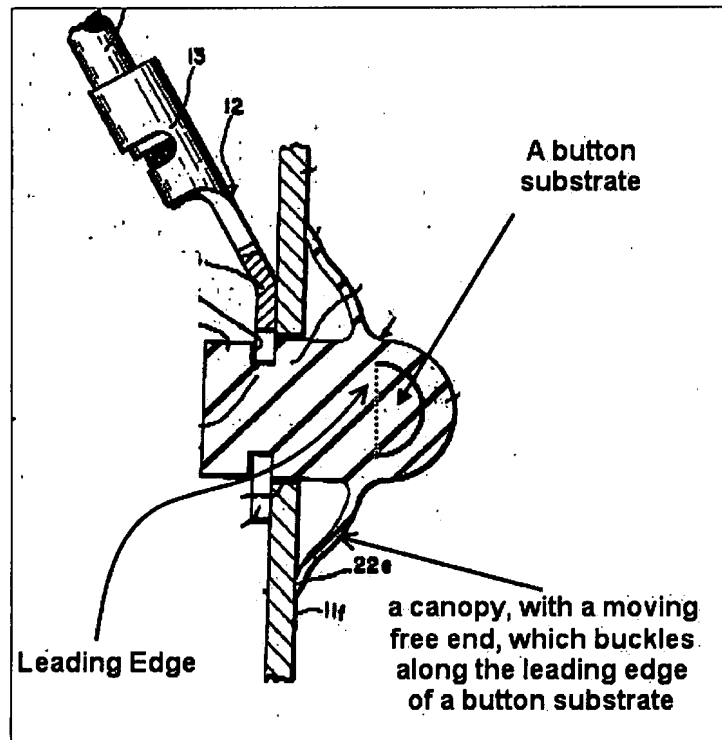
Apprille'071 teaches a cartridge (#14 figure 1) with a blade unit including a housing (#16 figure 1) that carries one or more shaving blades (#18 figure 1), a handle (#30, figure 3) with a handle casing (#42, figure 3), an interconnect assembly disposed at an end of the handle casing (#26, figure 3), a release button comprising a button substrate (since applicant has not defined or recited what is meant by substrate, the broadest reasonable interpretation must be applied: any portion of a button interior of

Art Unit: 3724

the exterior surface is rightly construed as a button substrate) and a flexible canopy (50) extending outwardly from the button substrate toward the handle casing (#50, figure 3). Apprille'071 further teaches that the edge of the canopy contacts the handle casing (#50 is in contact with #12, figures 16 & 17). Apprille'071 further teaches that the edge of the canopy contacts the handle casing when the button is in an unloaded position (#50 is in contact with #12, figures 16 & 17). Apprille'071 further teaches that the edge of the canopy contacts the handle casing when the button is in an actuated position (#50 is in contact with #12, figures 16 & 17). Apprille'071 further teaches that the edge of the canopy contacts the handle casing having an angle of no greater than 110 degrees. This is because the angle formed between the button and the handle casing varies and is at a maximum in the front center region of the canopy, which at no time is greater than 110 degrees (#50 is in contact with #12, figures 16 & 17). The angle between the canopy and the handle casing wall varies from about 50 degrees to about 110 degrees.

Apprille'071 does not teach that the flexible canopy buckles during actuation, and returns to an unbuckled state after actuation.

Kirk discloses a button as seen in the figure below:



In the same field of problem solving endeavor (concealing part of an interconnect assembly of a button) it would have been obvious to one skilled in the art at the time of the invention to modify Aprille'071 by making the canopy buckle at least along a leading edge of the button substrate during actuation, as taught by Kirk. The motivation to combine is that both canopies conceal an interconnect assembly, and so it would have been an obvious design choice to select a buckling canopy over a non-buckling canopy. The choice of canopy has no impact on the ability to "conceal at least part of an interconnect assembly". The substitution of one known button mechanism for another is within the level of ordinary skill in the art.

Regarding claims 25 and 26, Aprille'071 in view of Kirk does not teach that the canopy be between .3 and .6 mm thick, however this limitation lacks criticality. The

specification merely states this range as follows: "The thickness of the canopy can be between about 0.3 mm and 0.6 mm". No reason or rationale is provided, nor is the limitation of between .3 and .6 mm in any way essential to the function of the canopy which is to conceal the connecting assembly. A thickness of .1mm or 1mm would conceal just as effectively.

Alternatively, it would have been obvious to provide the canopy with a thickness of between 0.3mm and 0.6mm because it has been held that it is routine in the art to discover an optimum value of a result effective variable.

It has been held that the combination of elements known in the prior art to be used in accordance with their known functions *is unpatentable as a matter of law* absent a showing that the combination has results which are *unexpectedly* advantageous over the prior art. Please see *Sakraida v. Ag Pro, Inc.* U.S. Supreme Court No. 75-110 425 US 273, 189 USPQ 449 (1976), Which states "patent[s] for combination that only unites old elements with no change in their respective functions withdraws what is already known into field of its monopoly and diminishes resources available to skillful men" and [a] patent [which] simply arranges old elements with each performing the same function it had been known to perform, although perhaps producing a more striking result than in previous combinations...are not patentable under standards appropriate for a combination patent"; also see *Anderson's Black Rock, Inc. v. Pavement Salvage Co., Inc.* U.S. Supreme Court 396 US 57, 163 USPQ 673 (1969) which states "while the combination of old elements performed a useful function, it added nothing to the nature

Art Unit: 3724

and quality of the radiant-heat burner already patented". Similarly here, applicant makes use of a flexible canopy **to hide a portion of an interconnect assembly, which is the known purpose of such a canopy, as seen in the prior art (Kirk).**

The Supreme Court in *KSR International Co. v. Teleflex Inc. et al.* No. 04-1350, 550 U.S. ____ (2007) affirmed both Sakraida and Anderson's requirement that to be patentable a combination needed to provide some synergistic effect. See Slip op. at 13 lines 3-19. Using known elements for their known functions is *as a matter of law not patentable*, since it removes resources available to skillful men, contrary to U.S. Const., Art. I §8, cl.8. which provides patent monopolies to promote the progress of useful arts. See Slip op. *KSR* at 24 lines 5-7. Additionally, it has been held that one of ordinary skill in the art is not an automaton, and possesses ordinary creativity to use a mechanism for something *other than its avowed purpose* (*KSR* slip op. at 17, lines 1-9).

Each of the elements "release buttons in razors", "canopies in buttons" and "buckling canopies in buttons" are known as seen in the cited prior art (above); their combination is unpatentable absent a showing that one of ordinary skill would be unable to effect their combination, or their combination provides unexpectedly good results (more than a duplicated effect). Applicant is attempting to remove from the public subject matter which an ordinarily skillful person could have used, and would have had reason to do so.

Art Unit: 3724

4. Claims 12 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over in view of Aprille'071 in view of Kirk as applied to claims 13, 7-10, 13, 15, 18-21, 25 and 26 above and further in view of Jones et al. (USPN 6,898,855).

Jones et al teaches the use of thermoplastic elastomer in buttons for gripping by the hand. (Col. 8 lines 1-5). It would have been obvious to one skilled in the art at the time of the invention to use thermoplastic elastomer, since it has been known to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious mechanical design expediency. *In re Leshin*, 125 USPQ 416. The motivation to combine is to provide a more ergonomic grip as disclosed in Jones et al. (col. 4 lines 5-15).

Response to Arguments

5. Applicant's arguments filed 5/21/2007 have been fully considered but they are not persuasive, except as otherwise noted.

Regarding the cancellation of "the leading edge" from the claims, examiner has dropped the 112 first and second paragraph rejections thereunto appertaining.

Regarding applicants allegation that, the button substrate is clearly defined , examiner agrees, the button substrate is shown in the figures, (however, the recitation "button substrate" is quite broad, reading on nearly any component associated with a button) and the 112 second paragraph rejection has been removed.

Regarding applicants assertion that button 50 (of aprille) is not a canopy, firstly, applicant cannot show non-obviousness by arguing the references individually, as here,

where the rejection is based on a combination of references. *In re Keller*, 208 USPQ 871 (CCPA 1981). And secondly, it may rightly be construed as a canopy, since it extends outward, *in the shape of a canopy*. If applicant has some special technical definition for canopy, it would be wise to present it, so as to advance prosecution. Otherwise, the standard of claim interpretation during prosecution is as follows: "claims in a pending application should be given their broadest reasonable interpretation" consistent with the specification and prior art. *In re Pearson*, 181 USPQ 641 (CCPA 1974). See additionally MPEP 904.01, and also *In re Morris*, 127 F.3d 1048, 44 USPQ2d 1023 (Fed. Cir. 1997). It has been established that during examination, where applicant has the ability to amend claims, the standard of claim interpretation is that the broadest reasonable interpretation be given to all the terms of a claim, *absent a specific definition provided in the specification*, which would then control.

Regarding applicants assertion that "Aprille does not disclose or suggest a canopy that buckles during actuation" applicant cannot show non-obviousness by arguing the references individually, as here, where the rejection is based on a combination of references. *In re Keller*, 208 USPQ 871 (CCPA 1981).

Regarding applicants contention that the "footprint" of the Kirk flexible canopy becomes larger during actuation, this is immaterial to the claims as written. Buckling is not defined by applicant, and so the standard of claim interpretation during prosecution is as follows: "claims in a pending application should be given their broadest reasonable

Art Unit: 3724

interpretation" consistent with the specification and prior art. In re Pearson , 181 USPQ 641 (CCPA 1974). See additionally MPEP 904.01, and also In re Morris, 127 F.3d 1048, 44 USPQ2d 1023 (Fed. Cir. 1997). It has been established that during examination, where applicant has the ability to amend claims, the standard of claim interpretation is that the broadest reasonable interpretation be given to all the terms of a claim, *absent a specific definition provided in the specification*, which would then control. Buckle simply means to bend, which the canopy does. Examiner does not admit that there are not other additional definitions which Kirk would *also* meet, however this is immaterial to the claims as currently pending, since Kirk clearly meets them.

Regarding applicants allegation that the buckling of Kirk does not meet the limitation "the buckling maintains the position of the canopy between the wall and the button substrate" **this is not a claimed limitation** and may not be imported into the claims. This argument is spurious.

Kirk does not teach away from the claim limitations, "the flexible canopy buckles when the substrate is moved...causing the free edge to move along the wall", since Kirk clearly has a flexible canopy which buckles when actuated, and the free edge of the canopy clearly moves along the wall (as admitted by applicant at the top of page 3 of the remarks submitted 5/21/2007 "the flange 22 extending outwardly or flattening out"—which means **the free edge moved along the wall**). It should be clear that the canopy buckles at least close to the substrate, as shown in the figure reproduced above in the body of the rejection.

Applicants allegation that “none of the art of record teach or suggest... a flexible canopy” is simply a general allegation of patentability with nothing but conclusory statements. The limitations of the claims are clearly set forth as being met by the art of record, and so this allegation is not considered persuasive.

Applicants allegation that the canopy “does not ... equate to the Jones' grip and hence... the use of such a material on a canopy is not” motivated, is not persuasive. It is obvious as a matter of law to select a material suitable for a known purpose, and the fact that both the gripper and the button are intended to be used by a human hand is enough similarity to warrant use of the same material, especially since the material is provided for comfort. The canopy surely comes into contact with a finger during use, and so providing it as a known comfortable material is obvious. *In re Leshin*. 125 USPQ 416.

The limitations dealing with the buckling of the canopy have a decided lack of criticality. **The only function which the canopy serves is to “conceal at least a part of an interconnecting assembly” (applicants specification page 2, line 4), which the prior art of record clearly performs.** The function of concealing is not achieved by the buckling, but by the presence of the canopy. Should applicant receive a grant of patent rights on the basis of a limitation which does not relate to the problem being solved? The consistent answer from the courts is, No. **Where a limitation lacks criticality, a patent should not be granted. See In re Kuhle 188 USPQ 7 (CCPA 1975) “use of such a means...in lieu of those used in the references solves no**

Art Unit: 3724

stated problem and would be an obvious matter of design choice within the skill of the art." Also see Anderson's Black Rock, Inc. v. Pavement Salvage Co., Inc., 163 USPQ 673 (S. Ct. 1969) which states "the presence of the radiant burner in the same machine with the other elements is not critical or essential *to the functioning* of the radiant burner *in curing the problem* of the cold joint" (emphasis added). Similarly, applicant has stated a purpose for the canopy; namely, to "conceal at least part of an interconnecting assembly" which the prior art of record does. To add additional limitations, unnecessary to the solution of the problem, will not support a showing of non-obviousness. In Anderson's Black Rock, the court stated that "the convenience of putting the burner together with the other elements in one machine, though perhaps a matter of great convenience, **did not produce a "new or different function"** " (citing to Lincoln Co. v. Stewart Warner Corp., 303 U.S. 545, 549, 37 USPQ 1, 3.) . Applicant is in a similar situation, having provided known materials and mechanisms together, producing no "new or different function" and solving no problem not also solved by the prior art. Applicant has not given any evidence of criticality for the canopy besides that which is clearly already shown in the prior art (Aprille'071 alone conceals the interconnect assembly), and has shown no criticality at all for the buckling limitations of the canopy.

Conclusion

6. This is a Continued examination. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier

Art Unit: 3724

application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.


7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sean M. Michalski whose telephone number is 571-272-6752. The examiner can normally be reached on M-F 7:30AM - 3:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Boyer Ashley can be reached on 571-272-4502. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3724

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

SMM



KENNETH E. PETERSON
PRIMARY EXAMINER